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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91237315
Party	Defendant Universal Life Church Monastery Storehouse, Inc.se, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE  
MINISTRIES,

Opposer,

v.

UNIVERSAL LIFE CHURCH  
MONASTERY STOREHOUSE, INC.

Applicant.

Opposition No. 91237315

MOTION FOR PARTIAL JUDGMENT  
ON THE PLEADINGS

Pursuant to Fed. R. Civ. P. 12(c), 37 C.F.R. § 2.116, and T.B.M.P. § 504, Applicant Universal Life Church Monastery Storehouse, Inc. (“Applicant”) moves for partial judgment on the pleadings on the grounds that Opposer American Marriage Ministries (“Opposer”) has failed to sufficiently plead a claim for fraud on the Patent & Trademark Office (“PTO”). Opposer’s fraud claim is based on bare conclusions and formulaic recitations of the elements, and does not contain particular factual allegations supporting the inferences required to state a claim for fraud on the PTO, and therefore fails to satisfy Rules 8(a) and 9(b) of the Federal Rules of Civil Procedure. Accordingly, Applicant respectfully requests that the Board grant its motion and enter judgment dismissing Opposer’s claim for fraud on the PTO.

**I. BACKGROUND**

On October 17, 2017, Opposer filed its Notice of Opposition. (Dkt. No. 1.) Under the “Grounds for Opposition” section of the Notice cover sheet, Opposer identifies “Fraud on the

USPTO” and cites to *In re Bose Corp.*, 580 F.3d 1240, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009).

(*Id.*) Opposer’s Notice of Opposition contains the following allegations:

12. There were in fact other competing businesses using “get ordained” to describe what their services enable customers to do at the time Applicant signed the oath associated with its Application.

13. Prior fair users of the term “get ordained” have legal rights superior to the Applicant’s rights associated with the term.

14. When it filed its Application, Applicant had actual knowledge of other parties using “get ordained” in connection with the sale of retail goods and services enabling consumers to become or “get” ordained.

15. Applicant believed, or had no reason not to believe, that its claim of trademark rights in and to the mark GET ORDAINED would result in harm to others who would be denied unencumbered fair use of the term of art associated with their services.

16. When Applicant filed its Application, it fraudulently and with disregard for the truth, attested that Applicant had exclusive rights to use the mark GET ORDAINED in connection with its services.

17. In failing to disclose the facts of prior third party use of “get ordained” in connection with the services, Applicant intended to procure a registration to which Applicant was not entitled.

(*Id.* ¶¶ 12-17.)

## **II. ARGUMENT**

Opposer has failed to plead the necessary elements supporting a claim for fraud on the PTO, and has failed to plead particular factual allegations supporting the inferences necessary to sustain such a claim. Accordingly, the Notice of Opposition fails to comply with Rules 8(a) and 9(b) of the Federal Rules of Civil Procedure, fails to state a claim for fraud on the PTO on which relief may be granted, and the Board should enter judgment dismissing Opposer’s claim.

### **A. Legal Standards**

An applicant may file a motion for judgment on the pleadings for failure to state a claim on which relief may be granted “[a]fter the pleadings are closed, but within such time as not to delay the trial.” T.B.M.P. § 504.01; 37 C.F.R. § 2.116; Fed. R. Civ. P. 12(c) & 12(h)(2)(B). In deciding such a motion, all well-pleaded factual allegations of the nonmoving party must be accepted as true, and all reasonable inferences are drawn in favor of the nonmoving party. *Media Online Inc. v. El Clasificado*, 88 U.S.P.Q.2d 1285, 1288 (T.T.A.B. 2008). However, under Rule 8(a), Applicant must plead more than labels, conclusions, formulaic recitations of the elements of a cause of action, and naked assertions in order to state a valid claim for relief. *See Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Rather, Applicant must plead sufficient factual matter, accepted as true, to “state a claim to relief that is plausible on its face.” *Id.* (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged. *Iqbal*, 556 U.S. at 678. The Board is not bound to accept legal conclusions couched as a factual allegation. *Twombly*, 550 U.S. at 555; *see also Media Online*, 88 U.S.P.Q.2d at 1288.

In order to state a claim for relief, Opposer must allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) Opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing the Application. *See Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q.2d 1925, 1926 (T.T.A.B. 2014). An opposer may state a valid claim for relief on the grounds that an applicant committed fraud during the prosecution of its application for registration. T.B.M.P. § 309.03(c)(17).

A claim for fraud in the procurement of a trademark registration requires a showing that the applicant knowingly made a false, material representation of fact in connection with its application, with the intent of obtaining a registration to which it is otherwise not entitled. *See In re Bose*, 580 F.3d at 1243. Where, as here, the claim for fraud on the PTO rests on an allegedly fraudulent oath submitted in support of a trademark application, four elements must be shown:

“[A] plaintiff claiming that the declaration or oath in defendant’s application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed, must allege particular facts which, if proven, would establish that: **(1)** there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; **(2)** the other use had legal rights superior to applicant’s; **(3)** applicant knew that the other user had rights in the mark superior to applicant’s, and either believed that a likelihood of confusion would result from applicant’s use of its mark or had no reasonable basis for believing otherwise; and that **(4)** applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled.”

*Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1206 (T.T.A.B. 2007). This four-element *Intellimedia* test has been regularly applied by the Board and federal courts. *See, e.g., Daniel J. Quirk Inc. v. Village Car Co.*, 120 U.S.P.Q.2d 1146, 1149 (T.T.A.B. 2016); *The Scooter Store, Inc. v. SpinLife.com, LLC*, 777 F. Supp. 2d 1102, 1110 (S.D. Ohio 2011); *Hana Financial, Inc. v. Hana Bank*, 500 F. Supp. 2d 1228, 1234 (C.D. Cal. 2007).

When pleading a claim for fraud on the PTO, Rule 9(b) requires that the circumstances constituting the alleged fraud must be stated with particularity. *See Dragon Bleu*, 112 U.S.P.Q.2d at 1927. Thus, Rule 9(b) sets forth a pleading standard higher than the general plausibility standard of Rule 8(a) under *Twombly* and *Iqbal*. *See Hood v. U.S.*, 659 Fed. Appx. 655, 667 (Fed. Cir. 2016) (In the context of a fraud claim, “a plaintiff must state factual

allegations with greater particularity than Rule 8 requires.”) (quoting *Twombly*, 550 U.S. at 569 n.14.). While scienter may be averred generally, Opposer must nonetheless plead “sufficient allegations of underlying facts from which a court may reasonably infer that a specific individual (1) knew of the withheld material information or of the falsity of the material misrepresentation, and (2) withheld or misrepresented this information with a specific intent to deceive the PTO.” *Dragon Bleu*, 112 U.S.P.Q.2d at 1929 (quoting *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312 (Cir. 2009)); *Media Online*, 88 U.S.P.Q.2d at 1287 (“[P]etitioner has failed to state a claim for fraud because it has failed to plead particular facts sufficient to establish that respondent knowingly made false statements.”); *Hood*, 659 Fed. Appx. at 666 (affirming dismissal of fraud claim where plaintiff failed to “allege underlying facts from which the court could infer that any of the [defendant’s] actions were ‘committed with the requisite state of mind.’”)

**B. Opposer Fails to State a Claim for Fraud on the PTO**

Opposer fails to state a claim for fraud on the PTO because its Notice of Opposition rests entirely on bare conclusions and formulaic recitations of the elements, and contains no particular factual allegations from which the Board could reasonably infer that Applicant engaged in fraudulent conduct. More specifically, Opposer fails to plausibly allege facts supporting the conclusion that (1) there was in fact another user of the same or a confusingly similar mark to Applicant’s GET ORDAINED mark at the time Applicant’s oath was signed; (2) such other user(s) had legal rights superior to Applicant’s; (3) Applicant knew that such other user(s) had rights superior to Applicant’s, and either believed that a likelihood of confusion would result from Applicant’s use of its mark or had no reasonable basis for believing otherwise;

and that (4) Applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled.

### **1. Opposer Fails to Identify Third-Party Users and Uses**

In order to state a claim, Opposer must plead particular facts sufficient to establish that there was another use of the GET ORDAINED mark at the time Applicant's oath was signed. *See Intellimedia*, 43 U.S.P.Q.2d at 1206. However, the Notice of Opposition contains a single conclusory sentence on this topic: "There were in fact other competing businesses using 'get ordained' to describe what their services enable customers to do at the time Applicant signed the oath associated with its Application." (Dkt. No. 1 ¶ 12.) Opposer does not identify these "other competing businesses," the nature of their services, where they advertised or provided their services, how they advertised or provided such services, or how they allegedly used the term "get ordained." Opposer has provided only a "formulaic recitation[] of the elements of a cause of action," which the Supreme Court has held insufficient to state a claim under Rule 8, and does not come close to meeting the heightened factual particularity standard of Rule 9(b). *See Iqbal*, 556 U.S. at 681; *Exergen Corp.*, 575 F.3d at 1327 ("Rule 9(b) requires identification of the specific who, what, when, where, and how of the material misrepresentation or omission committed before the PTO."); *Bauer Bros. LLC v. Nike, Inc.*, 159 F. Supp. 3d 1202, 1202 (S.D. Cal. 2011) (Dismissing fraud counterclaim where the counterclaimant failed to allege "a specific person or entity" who previously used the mark in question on the goods in question). Accordingly, Opposer has failed to sufficiently plead this element of its claim as required under *Intellimedia*.

### **2. Opposer Fails to Allege Third Party Users Had Superior Rights**

In order to state a claim, Opposer must plead particular facts sufficient to establish that the

third-party users of the GET ORDAINED mark had rights superior to those of Applicant's at the time Applicant submitted its oath. *See Intellimedia*, 43 U.S.P.Q.2d at 1206. However, on this matter as well, the Notice of Opposition relies on a single conclusory sentence: "Prior fair users of the term 'get ordained' have legal rights superior to the Applicant's rights associated with the term."

This is merely a legal conclusion set forth without any factual support, which the Board need not accept in deciding a motion for judgment on the pleadings. *See* T.B.M.P. § 504.01 ("Conclusions of law are not taken as admitted"). Opposer does not allege that the supposed third-party users began their use prior to Applicant or provide any other factual details that would support the conclusion that they have established superior rights to Applicant. *See Hana Financial*, 500 F. Supp. 2d at 1235 (*Intellimedia* test "calls for the pleading of *particular* facts that would establish...superior legal rights in the...mark.") (emphasis in original). Opposer must allege particular facts supporting the conclusion that third parties had superior rights, because "[i]t is *only* when another's *rights*, not just *use*, are 'clearly established,' that 'good faith' is eliminated." *Id.* at 1236. Because Opposer has not done so, Opposer fails to sufficiently plead this element of its claim.

### **3. Opposer Fails to Allege that Applicant Knew of Third Party Uses or Believed Third Parties Had Superior Rights**

In order to state a claim for fraud on the PTO, Opposer must allege particular facts supporting the conclusion that Application knew that other users of the GET ORDAINED mark had rights in the mark superior to Applicant's, and either believed that a likelihood of confusion would result from Applicant's use of the GET ORDAINED mark or had no reasonable basis for believing otherwise. *See Intellimedia*, 43 U.S.P.Q.2d at 1206. It is not sufficient merely to allege the existence of third-party users, nor even that the Applicant knew of such third party users, because the oath is couched in terms of an applicant's "knowledge and belief" as to others' right to use the

mark in a manner likely to cause confusion.<sup>1</sup> *Id.* at 1206-07; *see also Sovereign Military Hospitalizer Order of St. John of Jerusalem of Rhodes and of Malts v. The Fl. Priory of the Knights Hospitallers of the Sovereign Order of St. John of Jerusalem, Knights of Malta, the Ecumenical Order*, 703 F.3d 1279, 1290 (11th Cir. 2012) (“*Priory*”)(“The declarant-focused text of the application oath requires the signatory's good-faith, subjective belief in the truth of its contents.”); *Hana Financial*, 500 F. Supp. 2d at 1236; *Scooter Store*, 777 F. Supp. 2d at 1112.

Accordingly, “the Board frequently has held that an applicant's failure to disclose to the PTO the asserted rights, of another person is not fraudulent unless such other person was known by applicant to possess a superior or clearly established right to use the same or a substantially identical mark for the same or substantially identical goods or services as those in connection with which registration is sought.” *Intellimedia*, 43 U.S.P.Q.2d at 1206-07. “[I]f the other person's rights in the mark, vis-a-vis the applicant's rights, are not known by applicant to be superior or clearly established, e.g., by court decree or prior agreement of the parties, then the applicant has a reasonable basis for believing that no one else has the right to use the mark in commerce, and the applicant's averment of that reasonable belief in its application declaration or oath is not fraudulent.” *Id.* at 1207; *see also Priory*, 702 F.3d at 1292; *Hana Financial*, 500 F. Supp. 2d at 1236; *Scooter Store*, 777 F. Supp. 2d at 1112.

In the present case, Opposer does not allege any facts necessary to satisfy this requirement. First, Opposer does not allege facts supporting the inference that Applicant had

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<sup>1</sup> Applicant's oath submitted with its Application states, in relevant part: To the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.

knowledge of third parties using the GET ORDAINED mark. Rather, Opposer states the bare conclusion that “Applicant had actual knowledge of other parties using ‘get ordained’ in connection with the sale of retail goods and services enabling consumers to become or ‘get’ ordained.” (Dkt. No. 1 ¶ 14.) Opposer alleges no factual details regarding who these users are, how they used “get ordained,” or how or when Applicant supposedly learned of such uses. This is plainly insufficient under governing Federal Circuit law. *See In re BP Lubricants USA Inc.*, 637 F.3d 1307, 1311 (Fed. Cir. 2011) (general allegation that the defendant “knew” something is insufficient to satisfy Rule 9(b) without factual detail supporting the inference); *see also Exergen Corp.*, 575 F.3d at 1330.

Moreover, Opposer does not allege—even in a merely conclusory fashion—that Applicant knew or believed that any third parties had rights in the GET ORDAINED mark that were superior to Applicant’s rights. This is a fatal defect, because it is Applicant’s belief that is key. If Applicant did not believe that third-party users had superior rights, then the oath was not false or fraudulent. *See Intellimedia*, 43 U.S.P.Q.2d at 1207; *Priory*, 702 F.3d at 1292; *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 755 (9th Cir. 2006). By failing to plead that Applicant knew or believed that the third party users had superior rights to use the GET ORDAINED mark, Opposer has failed to state a claim for fraud on the PTO.<sup>2</sup>

#### **4. Opposer Fails to Plead Applicant’s Intent to Deceive**

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<sup>2</sup> Of course, even if Opposer had pleaded that Applicant knew or believed that third parties had superior rights in the GET ORDAINED mark, Opposer would still need to plead particular facts supporting that inference, “and that a likelihood of confusion would result from applicant’s use of its mark...[or that Applicant] had no reasonable basis for its averred belief that no other person had a right to use the same or a confusingly similar mark on or in connection with the goods or services identified in the application.” *Intellimedia*, 43 U.S.P.Q.2d at 1207. The Notice of Opposition is devoid of any such factual details.

In order to state a claim for fraud on the PTO, Opposer must allege not only that Applicant knowingly made a false statement, but did so with intent to deceive, in order to procure a registration to which it was not entitled. *Intellimedia*, 43 U.S.P.Q.2d at 1203; *In re Bose*, 580 F.3d at 1240. Opposer pleads only a bare recitation of this element, without any factual details plausibly supporting the inference that Applicant acted with the requisite deceptive intent. (Dkt. No. 1 ¶ 17.) This is plainly insufficient under Rule 8(a) and Rule 9(b). *Exergan*, 575 F.3d at 1326-27. Indeed, by failing to plead facts supporting the first, second, and third elements of the *Intellimedia* test, Opposer has inherently failed to plead facts supporting the fourth element. *See Priory*, 702 F.3d at 1291 (“Pace could not have intended to deceive the PTO in attesting to an oath that he believed was entirely accurate.”); *Scooter Store*, 777 F. Supp. 2d at 1112 (“If a petitioner fails to plead adequately the third element, ‘[a] fortiori, petitioner has also failed to sufficiently plead the fourth element of the claim.’”) (quoting *Intellimedia*, 43 U.S.P.Q.2d at 1208).

### **III. CONCLUSION**

For the reasons stated above, Applicant respectfully requests that the Board grant its motion and enter judgment dismissing Opposer’s claim for fraud on the PTO.

DATED: March 14th, 2018

Respectfully submitted:

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## **CERTIFICATE OF SERVICE**

I hereby certify that I served the foregoing on Opposer's counsel of record by email transmission to [nancy.stephens@foster.com](mailto:nancy.stephens@foster.com), pursuant to Trademark Rule § 2.119(b), 37 C.F.R. § 2.119(b).

Dated: March 14th, 2018

s/ Matt Kostoulakos/  
Matt Kostoulakos/